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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,373	01/12/2001	Akio Tanabe	P107156-00040	9467

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EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/758,373

Applicant(s)

TANABE ET AL.

Examiner

SHIBRU HELEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/13/05
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/13/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The amendments, filed 05/13/2005, have been entered and made of record. Claims 1-11 are pending. In view of the Applicants' amendments to the title and the drawing in fig. 2, the objection to the title and the drawing in fig. 2 are hereby withdrawn.

***Response to Arguments***

2. Applicant's arguments filed 06/13/05 have been fully considered but they are not persuasive.

In re page 10, Applicant states "Uehara does not disclose that the DVD and CD are played back in accordance with registered contents of the custom file, which was generated to have the first recording medium alone registered therein." In re page 12, Applicant states "Yamauchi also does not disclose or suggest a custom file having the first recording medium alone registered therein."

In response, the Examiner respectfully disagrees. Uehara teaches that a custom file (or reproduction manager information) for each of the first recording medium (DVD disk 1-4) or the second recording medium (CD N-1 – N+2) is generated and stored in the manager information memory device (300) in advance (col. 5 lines 62-67; col. 8 lines 18-32. See also Fig. 2). Since the reproduction manager information (VMGI or TOC) for each of the first and second recording medium is separately generated and stored with respect to the others (see col. 6 lines 1-14; col. 7 lines 2-6 and 36-49), each custom file or reproduction manager information must be stored alone in the memory device. The custom file or the reproduction manager information is not shared

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between recording medium; therefore the custom file for each of the recording medium is generated and stored alone in the memory device (300).

It is noted that in the instant application, the memory section (102) (Fig. 13) “is used as a work area which is used when the program is executed and where, for example, a custom file to be discussed later is registered or various disc information including a management table to be discussed later is set and stored (see page 11); “an auto update operation is carried out to read information of discs stored in the disc changer 1 and register the disc information in the memory section 102” (page 12); “in this embodiment, for example, disc in/out information of a disc at each storage position in the disc changer 1 has been stored in the memory section 102 beforehand, it is determined in step S122 whether there is a disc or not, and when there is a disc at a new disc storage location which has not been existed before, the disc is recognized as a newly added one” (page 13); and “the process of the steps S126 and S127 does not erase disc information (disc type, disc title, artist's name, type ID) of one disc updated and registered in the memory section 102 when that disc is unloaded from the disc changer 1, and automatically adds the ID information and disc information of the disc remaining in the memory section 102 even if the same disc is reloaded into the disc changer 1 (the storage location may differ from the previous one) and is actually a newly added disc. Apparently, discs are managed based on, not storage locations, but ID information”(page 15).

It is respectfully submitted that the manager information memory device (300) taught in Uehara performs the same functions as of the instant application memory section (102).

3. In response to applicant's argument that Yamauchi fail to show custom file having the first recording medium alone registered therein, the Yamauchi reference was used to show menu display means for displaying a selection menu for custom files where registration is to be made to thereby prompt a user to select one of said custom files. However, the primary reference Uehara discloses the first recording medium is registered alone (see paragraph 2 above).

In view of the above, the Examiner believes that the custom files of the DVD or the CD are registered in the memory device 300 in separate position (alone) in advance for the reproduction purpose. The claimed invention does in fact read on the cited references for at least the reasons discussed above and as stated in the detail Office Action as follows. This Office action is now made final.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C 102(e) as being anticipated by Uehara (US Pat. No.6118738).

Claims 6-8 and 10 will be discussed first.

Regarding **Claim 6**, Uehara discloses a recording medium playback apparatus for a recording medium playback system in which a first recording medium (see DVD folder of fig.1) having reproduction information recorded thereon and a second recording medium (see CD folder of fig.1) on which reproduction information and playback control information (see Read

VMGI\_MAT,TT\_SRPT(A5) and read TOC(A6) of fig.3) for controlling a playback order of that reproduction information are recorded are both installable and which plays back said first and second recording media, said method comprising:

control means (see MP(207) of fig.1) for generating a custom file having said first recording medium alone registered therein (see fig.1 disk manager information memory device (300) and DVD reproduction system (205) and col. 3 lines 65-67, col. 5 lines 1-13 and col. 6 lines 1-6, col. 6 lines 1-14, col. 7 lines 2-6 and 36-49 and fig. 2, and col. 8 lines 18-32 and see the arguments in paragraph 2).

playing back means (see DVD reproduction system (205) and CD reproduction system (206) of fig.1) for playing back said first recording medium installed in said recording medium playback system in accordance with registered contents of said custom file (see fig.1 CD reproduction system (206), DVD reproduction system (205) and col.3 lines 59-67 and col. 6 lines 1-14).

Regarding **claim 7**, Uehara teaches that control means includes:

management table generating means (see READ VMGI-MAT TT-SRPT(A5) and READ TOC (A6)) for determining said type of a recording medium to be stored in said recording medium playback system and generates a management table including type information of said recording medium (col.6 lines 27-58); and

custom-file generating means (see write in memory device A7 of fig.3) for determining said type of said recording medium by referring to said management table upon reception of an instruction of registering said recording medium as said custom file, and registering said

recording medium in said custom file to be assigned in association with said type(see fig.3 Identify disk type(A4), and col. 6 lines 59-67 and col. 7 lines 1-6).

Regarding **claim 8**, Uehara teaches that when a recording medium registering instruction is issued during playback of said recording medium, said custom file generating means determines said type of said recording medium which is being played back by referring to said management table and registers said recording medium in said custom file to be assigned in association with said type ( see col. 8 lines 18-33 and 47-57).

Regarding **claim 10**, Uehara teaches instruction receiving means for receiving an instruction of designating said custom file and said recording medium to be registered in said custom file (see fig. 4 set property to DVD mode (C1), identify disk physically (C2) Read manager information (C4) and fig. 45 set property to CD mode (D1), identify disk physically (D2), Read TOC(D4), and col. 6 lines 59-67 and col. 7 lines 37-42);

input receiving means for receiving an input of data about said custom file and said recording medium (see fig.21 and col. 13 lines 46-57 and lines 60-65);

means for checking if said designated recording medium matches with classification of said designated custom file by referring to said management table (see col.8 lines 3-16)

whereby said custom-file generating means registers said designating recording medium in said designating custom file when there is a match (see col. 8 lines 3-9).

Regarding **Claims 1-3 and 5**, these claims are method claims corresponding to apparatus claims 6-8 and 10, respectively. Therefore, claims 1-3 and 5 are analyzed and rejected as previously discussed with respect to claims 6-8 and 10.

***Claim Rejections - 35 USC § 103***

6. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uehara '738 in view of Yamauchi et al. (USPN 6,020,982).

Claim 9 will be discussed first. Regarding **claim 9**, Uehara teaches instruction receiving means for receiving an instruction of designating said custom file and said recording medium to be registered in said custom file (see fig. 4 set property to DVD mode (C1), identify disk physically (C2) Read manager information (C4) and fig. 45 set property to CD mode (D1), identify disk physically (D2), Read TOC(D4), and col. 6 lines 59-67 and col. 7 lines 37-42). However, Uehara fails to teach menu display means for displaying a selection menu for custom files where registration is to be made to thereby prompt a user to select one of said custom files and list display means for displaying a list of those of recording media stored in said recording medium playback system, which are registrable by referring to said management table.

In the same field of endeavor, Yamauchi teaches a recording playback apparatus (Fig. 1, machine 600) in which a first recording medium (Fig. 1, cards 811/400, unit 500, or VTRs 807/808) having reproduction information recorded thereon and a second recording medium (Fig. 1, cards 811/400, unit 500, or VTRs 807/808) having reproduction information recorded thereon. Yamauchi further teaches menu display means for displaying input sources to thereby prompt a user to select one of said input sources and list display means for displaying a list of those of recording media stored in said recording medium playback system (see Figs. 88-90; col. 4 line 33 – col. 5 line 10; col. 51 line 34 – col. 52 line 38). In light of the teaching from Yamauchi, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the recording medium playback apparatus disclosed by Uehara menu



display means and list display means as claimed in order to allow a user to monitor at a glance which recording medium is currently played back.

Regarding **claim 4**, this claim is a method claim corresponding to the apparatus 9. Therefore, claim 4 is analyzed and rejected as previously discussed with respect to claim 9.

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIBRU HELEN whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, NGOC Y. VU can be reached on 571 272 7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru  
September 19, 2005



NGOC-YEN VU  
PRIMARY EXAMINER